

Remarks:

Applicants appreciatively acknowledge the Examiner's confirmation of receipt of applicants' claim for priority under 35 U.S.C. § 119(a)-(d). The Examiner noted that applicant has not filed certified copies of the priority applications as required by 35 U.S.C. § 119(b). Concurrent herewith, applicants filed a claim for priority together with the certified copy of the German Patent Application 199 35 126.0, filed July 27, 1999.

Reconsideration of the application is requested.

Claims 14 to 31 remain in the application. Claims 14 to 17, 19, 21, 22, 24, and 28 to 31 have been amended.

In items 3 and 4 on page 2 of the above-identified Office action, the Examiner objected to the specification because of various informalities.

It is respectfully believed that reference numeral 3 is a general reference to port units 3<sub>1</sub> through 3<sub>N</sub>. Thus, it is believed that use of reference numeral 3 throughout the specification is correct.

The objection to page 18 has been corrected.

Withdrawal of the objections to the specification is kindly requested.

In items 7 to 23 on pages 2 to 4 of the above-identified Office action, the Examiner objected to the claims because of various informalities.

The Examiner's corrections suggested in items 7, 8, and 10 to 23 have been made. It is respectfully noted that each of these changes is a matter of style and, therefore, are made for reasons of clarity and not for substantive reasons. Thus, the changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

The suggested correct in item 9, however, has not been made because the phrase "at least one of" refers to at least one of:

(1) cell; and

(2) at least one data packet.

Thus, the suggested change in item 9 would be incorrect.

On pages 5 to 8 of the above-identified Office action, various claims have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

In item 27, claims 14, 21, 22, 24, 26, 26, 28, and 29, the Examiner is unclear as to the meaning of "port units." It is respectfully believed that the "plurality of port units" is used first in the claims and shortened version "port units" is used thereafter for efficiency in length of the claims by reducing the repeated instances of "plurality of." Thus, there is only one set of port units.

In item 28, the Examiner indicates a belief that various phrases are unclear in claims 14, 16, 18, 21, 22, 24, 26, 26, 28, and 29. As there is only one set of port units, it is respectfully believed that the cited claim language is clear and need not be amended.

In response to item 29, the "steps" referred to in the phrase "recombining the cells received in a plurality of steps into data packets" means that the cells are received in steps.

In response to item 30, the Examiner requested amendment of the cited phrase, which is set forth above in claim 22. This

change makes clear that the means are part of each control unit of the port units and the central switching unit. Accordingly, the control unit mentioned in claim 23 in item 31 carries out the method of claim 14.

In response to item 32, the "information" referred to is the "respective information item" set forth earlier in the text of claims 28 and 29.

In response to item 33, applicants have provided that the signal has "data packets" in claims 14, 21, and 22. Thus, antecedent basis exists for "each data packet" in claims 14, 21, and 22. These changes also address the rejection in items 34 and 35 with respect to claims 14, 15, 21, and 22.

In response to item 36, it is respectfully submitted that antecedent basis exists for the cited phrase in part (f) of claim 14.

In response to item 37, "the availability information" in claims 28 through 31 has been changed to "availability request information." Accordingly, antecedent basis is believed to exist.

Finally, the Examiner objected to claim 25 in item 39 because it was believed that the claim is no different from claim 24. It is respectfully noted that claim 25 provides that "said collision resolution unit is integrated in said central switching unit" but claim 24 is silent with respect to integration. Thus, applicants respectfully believe that claim 24 is broader than claim 25 and, therefore, these claims have not been amended.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above noted changes to the claims are provided solely for the purpose of satisfying the requirements of 35 U.S.C. § 112. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In items 41 to 44 on pages 8 to 9 of the above-identified Office action, claim 23 has been rejected as being fully anticipated by Cordell (U.S. 5,367,520) under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found on page 16, line 7, to page 17, line 19, of the specification of the

instant application. Therein, it is described that the availability information can be combined in the form of a contention **request** vector (Crreq), which, in this context, is an availability request information. Accordingly, "availability information" has been changed to "availability request information" in all instances in the claims.

In the present invention, the availability request information contains the request for those other port units having cells for transmission in the respective "requesting" port unit." The method and system for routing cells in and ATM switch according to Cordell, in contrast, does not use such an availability request information. Accordingly, Cordell cannot be said to anticipate claim 23, and this rejection is now moot.

In items 46 to 81 on pages 9 to 17 of the above-identified Office action, claims 14, 16, 20, 22, and 24 have been rejected as being obvious over Cordell in view of Cai et al. (U.S. 6,134,246; hereinafter "Cai") under 35 U.S.C. § 103.

Cai also fails to disclose or suggest the availability request information of claims 14, 16, 20, 22, and 24. According to the present invention, prior to the transmission of cells, a request is started and the issuance of an authorization

information item CRgnt is awaited (see page 17, lines 16 to 19) until the predetermined cells are transmitted without the occurrence of a blocking or congestion. Thus, Cai and Cordell do not even relate to the subject matter of the present invention.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be

'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Cai to incorporate the features of Cordell, and there is no teaching or suggestion in Cordell to incorporate the features of Cai.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the **applicant's/appellant's** disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Cordell or Cai or to combine Cordell's and Cai's teachings to arrive at the claimed invention. Further, the



Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Cordell or Cai or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Even if one skilled in the art were to combine Cordell and Cai, there would be no way to result, from such a combination, in the non-suggested step of sending out an availability request information that is responded to by and authorization information as set forth in independent claims 14 and 21.

Considering the above-mentioned deficiencies of Cordell and Cai with regard to claim 14, and the fact that claims 15, 18, and 19 ultimately depend on claim 14, it is believed not to be

necessary at this stage to address the tertiary reference Diaz (U.S. 5,361,255) applied in the rejection of claims 15, 18, and 19 in items 82 to 85, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references as required by MPEP § 2143.

Considering the above-mentioned deficiencies of Cordell and Cai with regard to claim 14, and the fact that claim 17 ultimately depends on claim 14, it is believed not to be necessary at this stage to address the tertiary reference Kozaki et al. (U.S. 5,184,346) applied in the rejection of claims 17 in items 86 and 87, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references as required by MPEP § 2143.

Considering the above-mentioned deficiencies of Cordell and Cai with regard to claim 22, and the fact that claims 26 and 30 ultimately depend on claim 22, it is believed not to be necessary at this stage to address the tertiary reference Papierniak et al. (U.S. 5,825,751) applied in the rejection of claims 26 and 30 in items 88 to 103, and whether or not there is sufficient suggestion or motivation with a reasonable

expectation of success for modifying or combining the references as required by MPEP § 2143.

Considering the above-mentioned deficiencies of Cordell and Cai with regard to claim 14, and the fact that claims 27 and 31 ultimately depend on claim 14, it is believed not to be necessary at this stage to address the tertiary reference Papierniak et al. (U.S. 5,825,751) applied in the rejection of claims 27 and 31 in items 104 to 106, and whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying or combining the references as required by MPEP § 2143.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 14 through 31. In view of the foregoing, reconsideration and allowance of claims 14 to 31 are solicited.

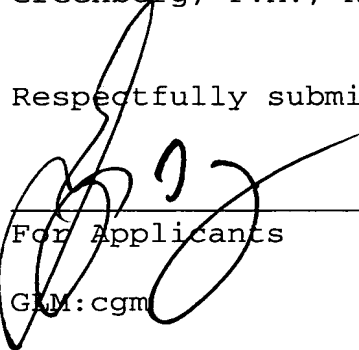
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Applic. No. 09/627,179  
Response Dated January 22, 2004  
Responsive to Office Action of October 22, 2003

If an extension of time for this paper is required, petition  
for extension is herewith made.

Please charge any other fees that might be due with respect to  
Sections 1.16 and 1.17 to the Deposit Account of Lerner and  
Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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For Applicants

GMM:cgm

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